

REMARKS

Claims 22, 25, 27, and 30 are currently pending in the present application. Claims 22 and 30 are the only claims in independent form.

Applicant wishes to express his appreciation for the courtesies extended Applicant's representative, Amy E. Rinaldo, during the numerous telephonic interviews conducted in August, 2006.

An Advisory Action was issued on August 4, 2006. The Advisory Action held that the claim limitations were not disclosed in the specification as originally filed. During one of the telephonic interviews the Examiner explained that the limitation in the claims for the use of only three chemical compositions in the suppository is not disclosed in the specification. It is respectfully submitted that the specification discloses the following at page 5, lines 12-22:

"The term "medication composition" 16 as used herein is meant to include a pharmaceutical composition that includes a medication. The medication includes, but is not limited to, valproate, sodium valproate, valproate salts, relproic acid, ergotamine, ergotamine-like agents, serotonin agonists, 5HT agonists, caffeine with ergots, aspirin, acetaminophen, naproxen sodium, tolfenamic acid, ibuprofen, other pharmacological agents, and any other similar prescription and nonprescription drugs known by those of skill in the art that can treat migraines or other similar disorders. As is described herein, a wide variety of migraine medications or agents are known in the art. Thus, any migraine medication or agent can be utilized with the present invention."

The laundry list of potential compositions that can be used as the medication in no manner can be interpreted to be a list of all the compositions that must be used in the suppository. Instead, the list provides a general listing of potential compositions that are available for use. One of skill in the art would not read this passage and determine that all of the listed compositions are required in the suppository. The skilled practitioner instead would assume that the listing provides examples of compositions that can be used in the suppository. The court has held that, "The test for determining compliance with the written description requirement is whether the disclosure of the

application as originally filed reasonable conveys to the artisan that the inventor had possession at that time of the later claimed subject matter..." *In re Edwards*, 558 [568] F.2d 1369; *In re Herschler*, 591 F.2d 693. Another court held that, "the test for determining whether the disclosure complied with the written description of the invention requirement is whether it would have reasonably conveyed to one of ordinary skill that the inventor invented the later-claimed subject matter." *In re Kaslow*, (Fed. Cir. 1983). The above-disclosure, taken directly from the patent application as filed, provides sufficient disclosure for the claim limitations and one of skill in the art would determine that the inventor did have possession of the claimed invention as of the filing date of the patent application. Accordingly, reconsideration of the rejection is respectfully requested.

Claim 22 stands rejected under 35 U.S.C. §102 as being anticipated by the Murata, et al. patent. Reconsideration of the rejection under 35 U.S.C. §102(e), as anticipated by the Murata, et al. patent, as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986) it was stated: "For prior art to anticipate under §102 it has to meet every element of the claimed invention."

In Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) it was stated: "Every element of the claimed invention must be literally present, arranged as in the claim."

The Office Action holds the instant independent claim recites "a medicine suppository comprising," which is open to valproate and other ingredients. Applicant has amended claim 22 to include closed language, thereby distinguishing over each of the cited references. It is respectfully submitted that no prior art reference discloses a medicine suppository consisting essentially of a medication selected from the group consisting of valproate, sodium valproate, and valproate salts. Since, the Murata, et al. patent does not disclose the suppository without the inclusion of additional compositions, the presently pending independent claim is patentable over the Murata, et al. patent and reconsideration of the rejection is respectfully requested.

Claims 22 and 30 stand rejected under 35 U.S.C. §102 as being anticipated by the Nau, et al. patent. Reconsideration of the rejection under 35 U.S.C. §102(e), as anticipated by the Nau, et al. patent, as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

The Office Action has held that the instant independent claims recite “a medicine suppository comprising,” which is open to valproate and other ingredients. Applicant has amended claim 22 to include closed language, thereby distinguishing over each of the cited references. It is respectfully submitted that no prior art reference discloses a medicine suppository consisting essentially of a medication selected from the group consisting of valproate, sodium valproate, and valproate salts. Since, the Nau, et al. patent does not disclose the suppository without the inclusion of additional compositions, the presently pending independent claim is patentable over the Nau, et al. patent and reconsideration of the rejection is respectfully requested.

Claim 22 stands rejected under 35 U.S.C. §102 as being anticipated by the Crocker, et al. patent. Reconsideration of the rejection under 35 U.S.C. §102(e), as anticipated by the Crocker, et al. patent, as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

The Office Action holds the instant independent claim recites “a medicine suppository comprising,” which is open to valproate and other ingredients. Applicant has amended claim 22 to include closed language, thereby distinguishing over each of the cited references. It is respectfully submitted that no prior art reference discloses a medicine suppository consisting essentially of a medication selected from the group consisting of valproate, sodium valproate, and valproate salts. Since, the Crocker, et al. patent does not disclose the suppository without the inclusion of additional compositions, the presently pending independent claim is patentable over the Crocker, et al. patent and reconsideration of the rejection is respectfully requested.

The remaining dependent claims not discussed above are ultimately dependent upon at least one of the independent claims discussed above. No prior art reference makes up for the deficiencies of that reference as applied against the

independent claims as no prior art reference discloses or suggests the invention as set forth in the claims as discussed in detail above.

In summary, the presently claimed invention is in condition for allowance, which allowance is respectfully requested. If any remaining issues exist, Applicant respectfully requests to be contacted by telephone at (248) 539-5050.

The Commissioner is authorized to charge any fee or credit any over-payment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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